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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/804,161  | 03/19/2004  | Junichi Iwata        | 8050-1007-1         | 7412             |
| 466   | 7590        | 01/26/2005           | EXAMINER            |                  |
| YOUNG & THOMPSON<br>745 SOUTH 23RD STREET<br>2ND FLOOR<br>ARLINGTON, VA 22202 |             |                      | PENG, KUO LIANG     |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1712                |                  |

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/804,161 | <b>Applicant(s)</b><br>IWATA ET AL. |  |
|                              | <b>Examiner</b><br>Kuo-Liang Peng    | <b>Art Unit</b><br>1712             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12/15/04 IDS.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/15/04, 4/21/04.</u> | 6) <input checked="" type="checkbox"/> Other: <u>See Continuation Sheet.</u>            |

Continuation of Attachment(s) 6). Other: English translation of JP 06-170857, JP 11-320699, JP 08-25378.

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities:

Applicants are advised to update the abstract.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Onozuka (JP 02-503028).

The instant claims are directed to molds. Therefore, “for producing a contact lens” and the specific materials and final properties of the contact lenses do not carry any weight of patentability. In other words, “for producing a contact lens” and the specific materials and final properties of the contact lenses are merely the intended use of the mold for, the intended material to be used or the intended properties of the contact lenses to obtain. As such, they do not carry any weight of patentability. Onozuka discloses a mold made of ethylene-vinylalcohol copolymer. Therefore, the instant claims are anticipated by Onozuka.

4. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Shepherd (US 4,121,896).

The instant claims are directed to molds. Therefore, “for producing a contact lens” and the specific materials and final properties of the contact lenses do not carry any weight of patentability. In other words, “for producing a contact lens” and the specific materials and final properties of the contact lenses are merely the intended use of the mold for, the intended material to be used or the intended properties of the contact lenses to obtain. As such, they do not carry any weight of patentability. Shepherd discloses a mold that comprises a male portion and a female portion (col. 2, lines 6-17, Examples 1(b) and 3(b)). Shepherd further

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especially suitable mold materials include ethylene vinyl alcohol copolymers, Nylon 6, Nylon 66, thermoplastic polyesters, etc. (col. 5, lines 15-33). Therefore, the instant claims are anticipated by Shepherd.

5. Claims 1-6 are rejected under 35 U.S.C. 102(a),(e) as being anticipated by Oyama (US 6 158 861).

The instant claims are directed to molds. Therefore, “for producing a contact lens” and the specific materials and final properties of the contact lenses do not carry any weight of patentability. In other words, “for producing a contact lens” and the specific materials and final properties of the contact lenses are merely the intended use of the mold for, the intended material to be used or the intended properties of the contact lenses to obtain. As such, they do not carry any weight of patentability. Oyama discloses a mold that comprises a male portion and a female portion. Oyama further especially suitable mold materials include ethylene vinyl alcohol copolymers, polyamide, polyesters, etc. (col. 5, line 44 to col. 7, line 7). Therefore, the instant claims are anticipated by Oyama.

6. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by LeFevre (US 4 208 365).

The instant claims are directed to molds. Therefore, “for producing a contact lens” and the specific materials and final properties of the contact lenses do not carry any weight of patentability. In other words, “for producing a contact lens” and the specific materials and final properties of the contact lenses are merely the intended use of the mold for, the intended material to be used or the intended properties of the contact lenses to obtain. As such, they do not carry any weight of patentability. LeFevre discloses a mold that comprises a male portion and a female portion. LeFevre further especially suitable mold materials include ethylene vinyl alcohol copolymers, Nylon 6, Nylon 66, thermoplastic polyesters, etc. (col. 2, lines 18-53 and col. 5, line 63 to col. 6, line 62). Therefore, the instant claims are anticipated by LeFevre.

7. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by JP857 (JP 06-170857).

The instant claims are directed to molds. Therefore, “for producing a contact lens” and the specific materials and final properties of the contact lenses do not carry any weight of patentability. In other words, “for producing a contact lens” and the specific materials and final properties of the contact lenses are merely the intended use of the mold for, the intended material to be used or the intended

properties of the contact lenses to obtain. As such, they do not carry any weight of patentability. JP857 discloses a mold that comprises a male portion and a female portion. JP857 further especially suitable mold materials include ethylene vinyl alcohol copolymers, polyamides, etc. ([0017]-[0031]). Therefore, the instant claims are anticipated by JP857.

8. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by JP378 (JP 08-025378).

The instant claims are directed to molds. Therefore, “for producing a contact lens” and the specific materials and final properties of the contact lenses do not carry any weight of patentability. In other words, “for producing a contact lens” and the specific materials and final properties of the contact lenses are merely the intended use of the mold for, the intended material to be used or the intended properties of the contact lenses to obtain. As such, they do not carry any weight of patentability. JP378 discloses a mold that comprises a male portion and a female portion. JP378 further especially suitable mold materials include ethylene vinyl alcohol copolymers, polyamides, polyesters, etc. (Claims). Therefore, the instant claims are anticipated by JP378.



9. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by JP699 (JP 11-320699).

The instant claims are directed to molds. Therefore, “for producing a contact lens” and the specific materials and final properties of the contact lenses do not carry any weight of patentability. In other words, “for producing a contact lens” and the specific materials and final properties of the contact lenses are merely the intended use of the mold for, the intended material to be used or the intended properties of the contact lenses to obtain. As such, they do not carry any weight of patentability. JP699 discloses a mold that comprises a male portion and a female portion. JP699 further especially suitable mold materials include ethylene vinyl alcohol copolymers, polyamides, polyesters, etc. ([0019]-[0024]). Therefore, the instant claims are anticipated by JP699.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The

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fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp  
January 19, 2005

Kuo-Liang Peng  
Primary Examiner  
Art Unit 1712



KUO-LIANG PENG  
PRIMARY EXAMINER